

Application No. 10/626,259
Amendment dated July 12, 2007
Reply to Non-Final Office Action dated May 1, 2007

Docket No.: 961_013

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes reference numeral changes to Fig. 12.

Attachment: Annotated sheet of Fig. 12 showing changes

REMARKS

The above-captioned patent application has been carefully reviewed in light of the non-final Office Action to which this Amendment is responsive. Claims 1, 6, 9, 12, 13, 16 and 17 have been amended in an effort to further clarify and distinguish the inventive concepts that are described in the application. In addition, Applicant herein also attaches a proposed red-lined version of Fig. 12, adding missing reference numerals so as to properly comport the drawings with the original specification. A formal version will be submitted following favorable consideration by the Examiner. To that end, it is believed no new matter has been added.

Claims 1, 6, 9 and 11-17 stand as pending in the present application. Claims 1, 6, 9, 11-12, and 13-17 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Claims 9 and 16-17 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 6, 9, 11, and 13-17 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,449,081 to Hughes ("Hughes"). Claim 12 stands rejected under 35 USC §103(a) over U.S. Patent No. 3,449,081 to Hughes in view of U.S. Patent No. 5,844,686 to Treptow et al. ("Treptow"). Finally, Claims 1 and 6 stand rejected under 35 USC §103(a) over U.S. Patent No. 3,780,935 to Lukacs et al. ("Lukacs") in view of U.S. Patent No. 5,844,686 to Treptow et al. Applicant respectfully requests reconsideration based on the amended claims, the proposed red-lined drawing, and the following discussion.

First, Claims 1, 6, 9, 12, 13, and 17 have each been amended to address each of the rejections under the 35 USC §112, first paragraph.

Applicant herein reserves the right to prosecute claims of the same scope or of broader scope than the claims prior to the present amendment in a related application (e.g., a continuation application). Applicant maintains all positions in support of patentability previously asserted.

With respect to Claim 16, the Examiner questioned the support provided in the specification of the claimed method. Applicant respectfully refers the Examiner's attention to paragraphs [0026], [0028] of the specification.

Further with respect to Claim 16, this claim has also been amended to address the antecedent basis rejection. The claim amendment neither alters the scope of the claims nor adds new matter. In that the claim amendment does not alter the claim scope, the claim amendment will not be regarded as "narrowing" claim amendment.

As to the prior art rejections and according to MPEP §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

With respect to the anticipation rejections of Claims 1, 6, 9, 11, and 13-17, it is respectfully asserted that Claims 1, 6, 9, 11, and 13-17 have been grouped improperly by the Examiner. According to the MPEP §707.07(d), entitled Improperly Expressed Rejections, a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. In the present instance, it does not appear that the Examiner has adequately shown or justified that the present rejection is equally applicable to all claims in the listed group. Applicant further respectfully asserts that Claims 1, 6, 9, 11, and 13-17 recite diverse subject matter and accordingly grouping of Claims 1, 6, 9, 11, and 13-17 into a common group is not permitted under MPEP 707(d).

Further with respect to the anticipation rejection of independent Claims 1, 6, 9 and 13, each of the foregoing claims commonly recite a "read window," in combination with numerous additional elements. Relative to the above combination, the Examiner has asserted that "the device of Hughes is equivalent to the claimed structure." *May 1, 2007 Office Action, page 8*. Applicant respectfully disagrees with this broad characterization and asserts the Examiner at least failed to show that Hughes provides any relevant teaching of a "read window." In addition, the Examiner has also stated

that “[t]he entire tip/cap is disclosed [in Hughes] as being transparent. Any portion of the tip . . . above a stepped area can be considered a read window as claimed.” *May 1, 2007 Office Action, page 4.* If in arguendo, the second part of the statement was true (which Applicant contends it is not), Applicant respectfully disagrees with the Examiner’s assertion that “[the] entire tip/cap is disclosed as being transparent.” Applicant has laboriously reviewed Hughes, but has failed to locate any teaching of the tip being transparent. The reference relates to the bottle being transparent and the syringe used in connection with the apparatus as being transparent, but it is evident that the cap is not clear. It would not have been logical for one of ordinary skill to have assumed that the cap would or should be made from a clear optically transparent material and therefore, the Examiner’s interposition of such a feature is evidence of hindsight. Because the cap is not made from an optically transparent material, Applicant herein respectfully asserts that Hughes fails to provide or remotely suggest any teaching relating to a “read window.”

Since each of Claims 1, 6, 9 and 13 commonly include a read window and since Hughes does not include this feature, it is respectfully submitted that the present anticipation rejection cannot stand. Claims 11 and 14-17 are believed allowable for the same reasons as Claims 9 and 13 upon which the foregoing claims depend. If the Examiner wishes to maintain the rejection of Claims 1, 6, 9, 11, and 13-17 over Hughes, the Examiner is respectfully requested to explain where in Hughes there is any teaching relating to “a read window.” The Examiner is further respectfully requested, when a reference is complex or shows or describes inventions other than that claimed by Applicant, to designate as nearly as practicable the particular part relied on. 37 C.F.R. §1.104. Reconsideration is respectfully requested.

With respect to the obviousness rejections of independent Claims 1 and 6, and as previously noted each of these claims include a “read window,” in combination with numerous additional elements. Relative to the above combination, the Examiner has asserted that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the dispensing device of Lukacs et al to incorporate the optical windows as

taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

May 1, 2007 Office Action, page 4.

According to *MPEP §2143* and in order to properly establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason to combine provided, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

Applicant respectfully asserts that the dispenser disclosed by Lukacs is intended for dispensing a liquid sealant when inserted into a container (tube) holding a blood sample. (Col. 1 line 45, col. 2 lines 17-18, col. 3 line 33). Figures 2-4 show that the dispenser is plugged into a tube. Thus, the intended use and the method of using the Lukacs' dispenser and that of the claimed metering tip are materially different. Furthermore, the stated purpose of the Lukacs' three ring sections is "to permit the dispenser . . . to be used with containers of various diameters." (Col. 2 lines 24-25.) Thus, Applicant respectfully asserts that using Lukacs' tube plug as a metering tip attachable to a metering system probe in an attempt to solve a problem of controlling fluid meniscus and oscillation is not an "identified, predictable solution" or a "known option" which "a person of ordinary skill has good reason to pursue," and which "leads to the anticipated success," as required under *KSR Intl. Co. v. Teleflex Inc.*, 550 U.S. ____ (Sup. Ct. 2007).

Hence, Applicant further respectfully asserts that the Examiner has not ascertained the differences between the prior art and the claims at issue as is required under *Graham v. John Deere Co, of Kansas City*, 383 U.S. 1 (Sup. Ct. 1966). If the

Examiner wishes to maintain an obviousness rejection of Claim 1 over the combination of Lukacs and Treptow, the Examiner is respectfully requested to explain where in the relied upon references there are teachings related to all the limitations of Claim 1, to determine whether there was an apparent reason to combine the known elements in the fashion claimed, as required under *KSR Intl. Co. v. Teleflex Inc.*, 550 U.S. ____ (Sup. Ct. 2007), and to demonstrate a reasonable expectation of success.

Regarding the claims discussed herein, Applicant's selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. Several dependent claim rejections have been selectively chosen by the applicants as examples, and are argued herein *supra*. Applicant's selective treatment of dependent claims of the application should not be taken as an indication that the Applicant believes that the Examiner's rejections of other dependent claims are otherwise sufficient. The Applicant expressly reserves the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

With respect to the claim rejections argued by Applicant herein *supra*, while Applicant herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, this highlighting of a particular claim element for such purpose should not be taken to indicate that Applicant has taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. Applicant maintains the right here forward to assert that each claim is patentable by reason of any patentable combination recited therein.

In summary, it is believed all of the claims of the present application to be in condition for allowance and an expedited Notice of Allowability is earnestly solicited.

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If the Examiner believes that contact with the Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's representative at the phone number listed below.

It is believed that no fees are due with the filing of this correspondence. However, the Director is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Dated: July 12, 2007

Respectfully submitted,

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